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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,460	01/23/2004	Takeshi Watase	248041US2	5461
22850	7590	06/16/2006		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER	
			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/762,460

Applicant(s)

WATASE ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-18 and 20-36 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/23/04; 3/24/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Election***

1. This action is in response to the provisional election mailed April 3, 2006.  
(Group I) Claims 1-18 and 20-36 were provisionally elected rendering (Group II) Claims 19 and 37 withdrawn as a non-elected invention.

### ***RESPONSE TO REQUEST FOR RECONSIDERATION***

2. Applicant's election with traverse of method of making an optical recording medium (Group II) is acknowledged. The traversal is on the ground(s) that "as the outstanding restriction requirement has not established that an undue burden would be required if the restriction requirement was not issued and if all the claims were examined together." Applicant indicated that M.P.E.P. 803 states that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims distinct or independent inventions."

The search of the 2 classes and subclasses would entail the requisite serious burden as the search for method of making is not the same as the article search. Additionally, the steps used in the method claims would not be expected to appear in the class/subclass of the product claims. Every optical disk is not made using the same method steps

The requirement is deemed proper and is therefore made **FINAL**.

***Claim Rejections – 35 USC 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, the phrase, "thermal radiative coatings satisfies 100  $\Omega$  or less" is indefinite. It is unclear what property the respective thermal radiative coating satisfies. Clarification is requested.

***Claim Rejections – 35 USC 102(e)***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 1, 3-5, 7, 10, 12, 15-18, 20-23, 25, 28, 30, 32 and 33-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Hirayama et al.

Hirayama discloses a coated body for a device comprising a substrate sandwiched between heat radiating substrates (coatings) (column 3, lines 9-13 and 33 and column 6, lines 4-8) having conductivity (column 3, lines 4-5) where the thickness of the coating is greater than 1um (column 2, lines 63-65) and has Ni (column 5, lines 62-65). Because Hirayama discloses a coated body comprising a substrate sandwiched between thermal radiative coatings, the integrated emissivities and equations 1-3 are inherent features. Additionally, the particle size of the carbon black is an inherent feature. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. The Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics. In claim 1, the phrase, "when the coated body is heated to 100 C" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. In claims 14, 15, 18,

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and 32, 34-36, the phrases, "chromate-free surface treatment," "in the salt spray test for testing corrosion resistance (72 hours) according to JIS-Z-2371," and "in the salt spray test for testing corrosion resistance (120 hours) according to JIS-Z-237" respectively introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

***Claim Rejections – 35 USC 102(e)***

7. Claims 1, 3-18 and 20-36 are rejected under 35 U.S.C. 103(a) as being anticipated by Nakase et al. (U.S. 7,009,284).

Nakase discloses a coated body comprising a substrate sandwiched between first and second radiation members (column 2, lines 30-36) comprising conductive radiation filler material (column 6, lines 57-61) and polyester resin (column 11, lines 31-32). Nakase further discloses a metal material comprising Ni and carbon black, along with a solvent (clear) coating (column 12, lines 18-41). Because Nakase discloses a coated body comprising a substrate sandwiched between thermal radiative coatings, the integrated emissivities and equations 1-3 are inherent features. Additionally, the particle size of the carbon black is an inherent feature. The claiming of a new use, new

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function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. The Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics. In claim 1, the phrase, "when the coated body is heated to 100 C" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. In claims 14, 15, 18, and 32, 34-36, the phrases, "chromate-free surface treatment," "in the salt spray test for testing corrosion resistance (72 hours) according to JIS-Z-2371," and "in the salt spray test for testing corrosion resistance (120 hours) according to JIS-Z-237" respectively introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

8. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The closest prior art does not teach or suggest the recited coated body further including wherein a difference (A-B) between the maximum value A and the minimum value B of a spectral emissivity in the wavelength range of 4.5 to 15.4 $\mu$ m is 0.35 or less. The prior art does not teach motivation or suggestion for modification to make the invention as instantly claimed.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should




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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson  
Patent Examiner  
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RENA DYE  
SUPERVISORY PATENT EXAMINER  
A.U. 1774 6/12/06